

DOCKET NO.: RUCC-0046 (98-0087US)
Application No.: 09/743,840
Office Action Dated: August 12, 2005

PATENT

REMARKS

The August 12, 2005 Official Action and references cited therein have been carefully considered. In view of the amendments submitted herewith and the following remarks, favorable reconsideration and allowance of this application are respectfully requested.

Status of the prosecution and current amendments:

As a preliminary matter, Applicants again request that the Attorney Docket Number of record in this case be changed from:

“13216-73220” to --**RUCC-0046 (98-0087)**--.

The oath or declaration has been deemed defective due to the presence of non-initialed alterations. A new oath or declaration has been required. Applicants are in the process of locating one of the three inventors so that a new declaration may be executed. However, inasmuch as five years has now elapsed since the original declaration was executed, this process has not yet been completed. As soon as the remaining inventor is located and can be contacted, a new declaration or oath will be executed and submitted to the Patent Office.

Claims 1, 2 and 5-10 are pending and were examined. All previous grounds of rejection were deemed moot and were withdrawn in view of new grounds of rejection.

Claims 1, 2 and 5-10 now stand rejected under 35 U.S.C. §112, first paragraph, for alleged lack of enablement with respect to (1) the starting material for generating callus tissue, (2) the use of acetosyringone in the method, and (3) the specific plasmids and *vir* genes employed in the method.

Claims 8 and 9 now stand rejected under 35 U.S.C. §102(b) as allegedly anticipated by Zhong et al. (1993), Plant Cell Reports 13: 1-6.

Claims 8 and 9 also stand rejected under 35 U.S.C. §102(b) as allegedly anticipated by Lee (1996) Plant Science 15: 1-8.

Claims 8 and 9 also stand rejected under 35 U.S.C. §102(e) as allegedly anticipated by U.S. Patent 5,948,956 to Lee et al.

Claims 1, 2 and 5-10 stand rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Komari et al. (1996), Plant J. 10: 165-174, in view of Christensen et al., (1996), Transgenic Research 5: 213-218, and further in view of Lee (1996, *supra*).

In accordance with the present amendment, claim 1 is amended herein to recite (1) culturing embryogenic tissue from seeds of a turfgrass plant in step (a); (2) inoculating the callus tissue with *Agrobacterium* carrying at least one vector for transformation, the vector comprising *virB*, *virC* and *virG* virulence genes from plasmid pSB1 or pSB4 in step (b); and (3) using *Agrobacterium* pre-incubated with acetosyringone for inoculating the callus tissue in step (b). Claims 7, 8 and 9 are canceled without prejudice. Claim 10 is amended to depend from claim 1 instead of from canceled claim 8.

Applicants respectfully assert that the presently amended claims are in condition for allowance, for the reasons set forth below.

The subject matter of the claims is enabled by the specification:

Claims 1, 2 and 5-10 stand rejected on the ground that the specification does not enable practice of the invention in the scope encompassed by the claims. Specifically, the examiner asserts that the specification enables claims to a method in which embryogenic

tissue is cultured from turfgrass seeds, and friable callus is inoculated in the presence of acetosyringone with *Agrobacterium* comprising a vector comprising the *virB*, *virC* and *virG* genes from plasmids pSB1 or pSB4.

Applicants disagree with these grounds of rejection under 35 U.S.C. §112, first paragraph. However, to advance the claims to allowance, claim 1 has been amended to include the recitations deemed necessary by the examiner to satisfy the enablement requirement. Accordingly, the method recited in amended claim 1 should be found fully enabled by present specification. Reconsideration and withdrawal of the rejection of claims 1, 2 5, 6 and 10 under 35 U.S.C. 112, first paragraph, is therefore respectfully requested.

The rejections for anticipation are moot:

Claims 8 and 9 stand rejected under 35 U.S.C. §102(b) as allegedly anticipated by Zhong et al. (1993), Plant Cell Reports 13: 1-6; and by Lee (1996) Plant Science 15: 1-8. Claims 8 and 9 also stand rejected under 35 U.S.C. §102(e) as allegedly anticipated by U.S. Patent 5,948,956 to Lee et al. Without acceding to the propriety or merits of these rejections, claims 8 and 9 have been canceled herein without prejudice. Accordingly, the rejections under 35 U.S.C. §102 (b) and (e) are rendered moot.

The claimed subject matter is not obvious in view of the cited references:

Claims 1, 2 and 5-10 stand rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Komari et al. (1996), Plant J. 10: 165-174, in view of Christensen et al., (1996), Transgenic Research 5: 213-218, and further in view of Lee (1996, *supra*). However, the examiner stated at page 8 of the Action, that “amendment of claim 1 to overcome the

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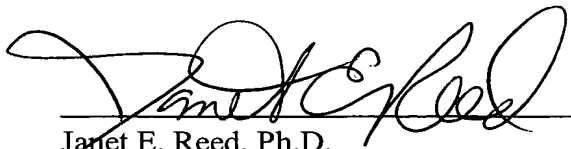
rejection under 35 U.S.C. §112, first paragraph, and the cancellation of claim 7, would obviate the obviousness rejection.” Without acceding to the propriety or merits of this rejection, Applicants note that the claims have been amended herein for the purpose of overcoming the rejection under 35 U.S.C. §112, first paragraph, and claim 7 has been canceled. As a result, the rejection under 35 U.S.C. §103(a) should also be overcome. Applicants therefore request reconsideration and withdrawal of that rejection.

Conclusion:

Applicants believe this paper to be fully responsive to all outstanding issues. In view of the amendments presented herewith and the foregoing remarks, the claims are considered to be in condition for allowance and the same is earnestly sought in an early and favorable action. If further discussion would facilitate advancement of this application to allowance, the examiner is invited to contact the undersigned attorney at the telephone number provided below.

Respectfully submitted,

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